

MARKED UP COPY OF THE SPECIFICATION SHOWING CHANGES:

Please amend the specification on page 13, lines 5-13 to read as follows:

“Deposit Information

Two thousand five hundred (2500) seeds of *Impatiens flaccida* have been placed on deposit with the American Type Culture Collection (ATCC), 10801 University Blvd., Manassas, Virginia, 20110-2209 under Deposit Accession Number PTA-1069 on December 1[4]5, 1999. This deposit was made in compliance with the Budapest Treaty requirements that the duration of the deposit should be for thirty (30) years from the date of the deposit or for five (5) years after the last request for the deposit at the depository or for the enforceable life of a U.S. Patent that matures from this application, whichever is longer. These impatiens seeds will be replenished should it become non-viable at the depository.”

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following arguments is respectfully requested.

Claims 1-12 have been deleted and new claims 13-30 have been amended. No new matter has been added as a result of these amendments. The Examiner is authorized to charge any additional claim fees due and owing as a result of the filing of this Amendment to deposit account no. 04-1644.

Oath or Declaration

The Examiner has rejected the declaration as being defective. The Examiner says that the declaration fails to identify the post office address of the inventor. Applicant respectfully traverses this rejection.

With respect to the issue raised by the Examiner regarding the inventor's address, the assignee of the present invention has represented to the undersigned attorney that Costa Rica does not have any postal codes. Apparently, mail in Costa Rica is delivered based solely on the address of the recipient. Therefore, Applicant submits the address provided in the declaration is complete. If the Examiner has additional questions or concerns regarding the declaration, she is invited to contact the undersigned attorney.

Drawing

The Examiner stated that color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 C.F.R. Section 1.84(a)(2) or (b)(2) is granted permitting their use as formal drawings. Applicant intends to file such a petition. However, Applicant wishes to hold the filing of such a petition in

abeyance until receipt of notification by the Examiner of allowable subject matter.

Double Patenting

Claims 2-4 and 6 are provisionally rejected under the judicially created doctrine of obviousness-double patenting as being unpatentable over claim 1 of each of co-pending Application Nos. 09/473,000 and 09/473,008. Applicant wishes to hold the filing of the necessary terminal disclaimers to overcome this rejection upon receipt of notification from the Examiner of allowable subject matter.

Claim Rejections – 35 U.S.C. Section 112

Claims 1 and 3-6 are rejected under 35 U.S.C. Section 112, first paragraph as failing to provide an adequate written description. More specifically, the Examiner stated that claim 1 was directed to any trailing interspecific *impatiens* plant. According to the Examiner, the specification only discloses the crossing of *Impatiens flaccida* with *Impatiens Hawkeri* resulting in progeny with a trailing habit, such as 2245B and 2257B. Applicant respectfully traverses this rejection.

Claims 1 and 3-6 have been deleted. Applicant will now address this rejection with respect to new claim 13. Applicant submits that new claim 13 is supported by an adequate written description. Specifically, new claim 13 is directed to an interspecific plant comprising a trailing habit produced by crossing an *Impatiens flaccida* with an *Impatiens hawkeri*. Interspecific *impatiens* plants having such a trailing habit and produced from such a cross are adequately described by the specification as admitted by the Examiner.

Thereupon, in view of the aforementioned amendments and arguments, Applicant submits that this rejection should be withdrawn.

Claims 1-6 are rejected under 35 U.S.C. Section 112, first paragraph as not being enabled by the specification. More specifically, with respect to claim 1, the Examiner states that this claim recites any trailing interspecific *impatiens* plant where the plant includes pollen, ovules, regenerable tissue cells and cuttings (claims 3-6). According to the Examiner, the state of the art at the time the invention was filed did not enable a person skilled in the art to make the invention because of a lack of guidance and uncertain predictability. The Examiner states that the specification does not provide sufficient amount or direction or guidance to enable a person skilled in the art to make the invention with the phenotype disclosed. Applicant respectfully traverses this rejection.

Claims 1-6 have been deleted. Applicant will now address this rejection in connection with new claim 13. Applicant submits that new claim 13 is sufficiently enabled by the specification. Specifically, new claim 13 is directed to an interspecific plant comprising a trailing habit produced by crossing an *Impatiens flaccida* with an *Impatiens Hawkeri*. Interspecific *impatiens* plants having such a trailing habit and produced from such a cross are adequately enabled by the specification as admitted by the Examiner.

With respect to claim 2, the Examiner stated that the specification does not disclose a repeatable process to obtain plants of 2245B and 2257B, seeds or plant parts therefrom, because it did not appear to the Examiner that the two parental lines were readily available to the public. Additionally, the Examiner stated that even if the parents were available, then the progeny would not be identical to the named plants

Applicant understands the Examiner's rejection to be two fold. First, the Examiner states that the specification does not disclose a repeatable process to obtain plants of 2245B and 2257B, seeds or plant parts therefrom, because it did not appear to the Examiner that the two parental lines were readily available to the public. Applicant respectfully disagrees with the Examiner and submits that the two parental lines are publicly available. As stated on the bottom of page 4, line 30 – page 5, line 1, one of the parental lines, namely *Impatiens Hawkeri*, is publicly available from Pan American Seed Company. The second parental line, *Impatiens flaccida* has been deposited with the A.T.C.C., which is discussed on page 13, lines 6-13 of the specification.

The second part of the Examiner's argument is that even if the parents were available, then the progeny would not be identical to the named plants unless both were inbred lines. Applicant has provided a detailed botanical description of plants 2245B and 2257B in Examples 1 and 2 of the specification. Thereupon, Applicant submits that one of ordinary skill in the art could easily cross the two parental lines (*Impatiens hawkeri* and *Impatiens flaccida*) and then using the information provided in these examples, identify plants 2245B and 2257B. Thereupon, Applicant submits that this rejection should be withdrawn.

Handwritten notes:
detailed description does not mean inbred
still unpredictable to many varieties

Claims 2-12 are rejected under 35 U.S.C. Section 1112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter Applicant regards as the invention. Specifically, the Examiner rejected certain wording in claims 2 and 7 as well as the claims dependent upon these claims. Applicant respectfully traverses this rejection.

Claims 2-12 have been deleted. Applicant has taken the Examiner's comments with respect to claims 2 and 7 into consideration in the drafting of new claims 13-30.

Handwritten note: OK

Thereupon, Applicant submits that this rejection should be withdrawn.

OK
Claim Rejections – 35 U.S.C. Section 102

Claims 1, 3, 4 and 6 were rejected under 35 U.S.C. Section 102(b) as being anticipated by Hope (P.P. 5,921), Hope (P.P. 5,698), Hope (P.P. 5,598).

Claims 1, 3, 4 and 6 have been deleted. In view of the deletion of these claims, Applicant submits that this rejection has now been rendered moot and should be withdrawn.

OK
Claim Rejections – 35 U.S.C. Section 103

Claim 5 is rejected under 35 U.S.C. Section 103(a) as being unpatentable over Hope (P.P. 5,921) in view of Banner et al.

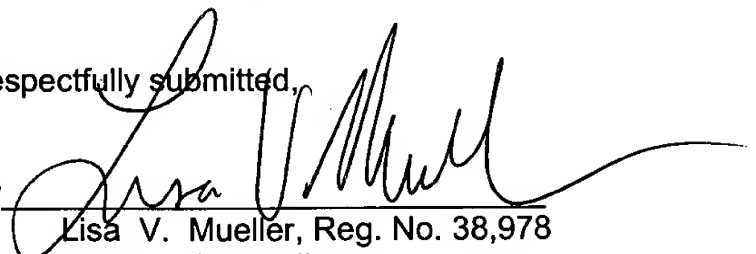
Claim 5 has been deleted. In view of the deletion of this claim, Applicant submits that this rejection has now been rendered moot and should be withdrawn.

Applicant submits that the claim is now in condition for allowance.

If any fees are incurred as a result of the filing of this paper, authorization is given to charge Deposit Account Number 04-1644.

Respectfully submitted,

By


Lisa V. Mueller, Reg. No. 38,978
Attorney for Applicants

CERTIFICATE OF MAILING

I hereby certify that this Amendment and any other documents referred to as enclosed herein, is being deposited with the United States Postal Service with sufficient postage at First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on September 19, 2001.

Susan Matz